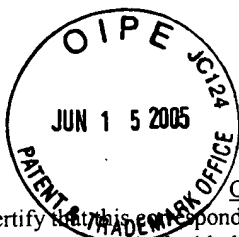PATENT

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Himanshu S. Amin

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Applicants(s): Curtis G. Wong, *et al.*

Serial No: 09/650,375

Filing Date: August 29, 2000

Examiner: Son P. Huynh

Art Unit: 2611

Title: SYSTEM AND METHOD FOR PROVIDING PROGRAM CRITERIA REPRESENTING AUDIO AND/OR VISUAL PROGRAMMING

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Dear Sir:

Applicant submits this brief in connection with an appeal of the above-identified patent application. A credit card payment form is filed concurrently herewith in connection with all fees due regarding this appeal brief. In the event any additional fees may be due and/or are not covered by the credit card, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1063 [MSFTP131US].

I.   Real Party in Interest (37 C.F.R. §41.37(c)(1)(i))

The real party in interest in the present appeal is Microsoft Corporation, the assignee of the present application.

II.   Related Appeals and Interferences (37 C.F.R. §41.37(c)(1)(ii))

Appellants, appellants' legal representative, and/or the assignee of the present application are not aware of any appeals or interferences which may be related to, will directly affect, or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III.   Status of Claims (37 C.F.R. §41.37(c)(1)(iii))

No claims have been withdrawn, canceled or allowed. Claims 1-67 stand rejected by the Examiner. The rejection of claims 1-67 is being appealed.

IV.   Status of Amendments (37 C.F.R. §41.37(c)(1)(iv))

No claim amendments have been entered after the Final Office Action.

V.   Summary of Claimed Subject Matter (37 C.F.R. §41.37(c)(1)(v))

A.   Independent Claim 1

Independent claim 1 recites a system for providing program criteria comprising: a server computer storing a plurality of tokens, each token having a system unique identifier for identifying a predetermined at least one of an audio and visual program; wherein the server is programmed to provide at least one token to a remote computer based on received selection criteria. (*See, e.g.* page 4, lines 10-14).

B.   Independent Claim 15

Independent claim 15 recites a computer-readable medium having computer-executable components comprising: a token database component for storing tokens, each token representing a different one of at least one of an audio and visual program; and a message component with which at least one token is transmitted in response to a request for the at least one token. (*See, e.g.* page 4, lines 15-20).

C.   Independent Claim 24

Independent claim 24 recites a system for providing program criteria comprising: means for storing token data representing a plurality of audio and/or visual programs (*See, e.g.* Figure 10 and page 36, lines 4-6); and means for providing selected token data in response to a query identifying program selection criteria. (*See, e.g.* Figure 10 and page 36, lines 9-11).

The aforementioned means for limitations are identified as claim elements subject to the provisions of 35 U.S.C. §112 ¶6. The corresponding structures are identified with reference to the specification and drawings in the parentheticals above corresponding to those claim limitations.

D.   Independent Claim 30

Independent claim 30 recites a method for providing program criteria to facilitate programming of a recording system, the method comprising: sending a token from one computer to another computer based on selection criteria received at the one computer, the token representing a specific at least one of an audio and visual program. (*See, e.g.* page 4, lines 21-27).

E.   Independent Claim 32

Independent claim 32 recites a method for providing program criteria to facilitate programming of a recording system, the method comprising: storing a plurality of tokens in a database at a first computer, each token identifying at least one of an audio and visual program; receiving selection criteria from a second computer; selecting at least one token based on the selection criteria; and sending a message to a remote computer, the message having the selected at least one token associated with the message. (*See, e.g.* Figure 10 and page 36, lines 4-11).

F.   Independent Claim 40

Independent claim 40 recites a system to facilitate remote programming of a recording system, comprising: a server operable to receive a token having data identifying at least one of a user and the recording system and identifying at least one of an audio and visual program, the server being operable to communicate program data, based on the token, to a programmable recording system to effect programming of the recording system to record the at least one of an

audio and visual program. (*See, e.g.* Figure 9 and page 34, line 22 – page 35, line 4).

G. Independent Claim 42

Independent claim 42 recites a system to facilitate remote programming of a recording system, comprising: a first server operable to receive data indicative of a user selection, the first server providing a request to a second server, the request having data identifying at least one of an audio and visual program selected by the user and data identifying at least one of the user and a recording system. (*See, e.g.* Figure 20 and page 63, line 26 – page 64, line 4).

H. Independent Claim 44

Independent claim 44 recites a user interface to facilitate remote programming of a recording system, comprising: a selectable display portion associated with at least one of an audio and a visual program; and a process associated with the display portion to effect programming of a recording system to record the at least one of an audio and visual program in response to selection of the display portion, wherein the process is resident at a server operable to communicate program data to the recording system based on the selection to effect programming of the recording system. (*See, e.g.* Figure 9 and page 33, line 8 – page 35, line 14).

I. Independent Claim 46

Independent claim 46 recites a method comprising: receiving program content criteria from a user via a communication link; selecting program content based on the program content criteria received from the user; transmitting a programming component identifying the selected program content, the programming component being operable to effect recording of a program corresponding to the program content. (*See, e.g.* Figure 9 and page 33, line 8 – page 35, line 14).

J. Independent Claim 51

Independent claim 51 recites a method comprising: transmitting for display on a remote computer information about at least one of audio and visual content; receiving from the user computer a selection of the content; and transmitting a programming component identifying the selected content, the programming component being operable to effect recording of a program corresponding to the program content. (*See, e.g.* Figure 9 and page 33, line 8 – page 35, line 14).

K.   Independent Claim 59

Independent claim 59 recites a method comprising: storing programming information; receiving from a computer user information and information describing at least one of audio and visual content; using the stored programming information and the user information to construct a token that includes information sufficient to program a recording system to record the at least one of audio and visual content; and transmitting the token via a communication link. (*See, e.g.* Figure 17 and page 59, line 11 – page 60, line 4).

VI.   Grounds of Rejection to be Reviewed (37 C.F.R. §41.37(c)(1)(vi))

A.   Claims 1-11, 24, 25, 27-36, 38-49, 51-57 and 59-66 are anticipated under 35 U.S.C. §102(a) over Ellis *et al.* (WO 00/04709).

B.   Claims 15-21, 50, 58 and 67 are unpatentable under 35 U.S.C. §103(a) over Ellis *et al.* (WO 00/04709).

C.   Claims 12-14, 22-23, 26 and 37 are unpatentable under 35 U.S.C. §103(a) over Ellis *et al.* (WO 00/04709) in view of Knudson *et al.* (US 6,536,041).

VII.   Argument (37 C.F.R. §41.37(c)(1)(vii))

A.   Rejection of Claims 1-11, 24, 25, 27-36, 38-49, 51-57 and 59-66 Under 35 U.S.C. §102(a)

Claims 1-11, 24, 25, 27-36, 38-49, 51-57 and 59-66 stand rejected under 35 U.S.C §102(a) as being anticipated by Ellis *et al.* (WO 00/04709). Applicants' representative respectfully requests that this rejection be withdrawn for at least the following reasons. Ellis *et al.* fails to disclose all limitations of the subject claims.

> A single prior art reference anticipates a patent claim only if it expressly or inherently describes ***each and every limitation*** set forth in the patent claim. *Trintec Industries, Inc. v. Top-U.S.A. Corp.,* 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California,* 814 F.2d 628, 631,

2 USPQ2d 1051, 1053 (Fed. Cir. 1987). *The identical invention must be shown in as complete detail as is contained in the ... claim.* Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (emphasis added).

The claimed invention relates to a system for providing program criteria to facilitate recording of a specific audio and/or visual program. In particular, independent claims 1, 24, 30, 32, 40, 42, 44, 46, 51 and 59 recite similar limitations, namely *a server computer storing a plurality of tokens, each token having a system unique identifier for identifying a predetermined at least one of an audio and visual program; wherein the server is programmed to provide at least one token to a remote computer based on received selection criteria.* Ellis *et al.* is silent regarding such novel aspects of the claimed invention.

In particular, applicants' claimed invention provides for employment of a token that comprises information related to a media program, and the token can be transmitted (*e.g.*, downloaded by a user and sent *via* e-mail) to a recording device to facilitate automatic programming of the recording device to record the media program associated with the transmitted token. Accordingly, for example, a host computer of a media program can make available to a user (*e.g.*, employing e-mail) a token for transmitting to one or more recording devices; and the token can contain all necessary information to effect recording of the media by the one or more recording devices that receive the token. Ellis *et al.* does not teach or suggest such novel aspects of applicants' claimed invention.

Rather, Ellis *et al.* relates to an interactive television program guide system with remote access. The system disclosed by Ellis *et al.* does not teach or suggest the use of a token having a unique identifier associated with at least one of an audio and visual program. Instead, the cited reference is limited to transmitting programming guide data (either continuously or in intermittent intervals) to effectuate changes to a local programming environment. A programming guide is not a token, one cannot transmit a programming guide to a recording device to achieve programming thereof. To the contrary, a programming guide is an interactive table that provides for a user to view available content for recording and through coupling of the remote device, the programming guide and the interactive equipment, recording of desired content can be achieved. Ellis *et al.* does not provide for novel functionality as in applicants' claimed invention where a user can send a token to any one or more of a plurality of recording

devices that will provide necessary information for the respective recording devices to initiate recording of media associated with the token. Thus, through the use of tokens, the invention as claimed provides for a decoupled framework to effect recording of content of interest.

The Examiner is reminded that the standard by which anticipation is to be measured is *strict identity* between the cited document and the invention as claimed, not mere equivalence or similarity. *See, Richardson* at 9 USPQ2d 1913, 1920. Since Ellis *et al.* fails in this regard, withdrawal of this rejection with respect to independent claims 1, 24, 30, 32, 40, 42, 44, 46, 51 and 59 (and the claims that depend there from), is respectfully requested.

B.   Rejection of Claims 15-21, 50, 58 and 67 Under 35 U.S.C §103(a)

Claims 15-21, 50, 58 and 67 stand rejected under 35 U.S.C. §103(a), as being unpatentable over Ellis *et al.* Withdrawal of this rejection is respectfully requested for at least the following reasons. The subject claims either directly (or indirectly *via* respective base claims) recite *the use of token(s) representing audio and/or video programs and transmitting such token(s)* in connection with effecting recording of the programs through use of the tokens. As noted *supra*, Ellis *et al.* does not teach or suggest the use of tokens let alone in the manner suggested by the subject claims; and this rejection should be withdrawn

C.   Rejection of Claims 12-14, 22-23, 26 and 37 Under 35 U.S.C §103(a)

Claims 12-14, 22-23, 26 and 37 stand rejected under 35 U.S.C. §103(a), as being unpatentable over Ellis *et al.* in view of Knudson *et al.* (US 6,536,041). This rejection should be withdrawn for at least the following reasons. The subject claims respectively depend from independent claims 1, 15, 24 and 32. As noted above regarding these independent claims, Ellis *et al.* does not teach or suggest *the use of unique identifying tokens for programming a recording system*; and Knudson *et al.* does not make up for such deficiencies of Ellis *et al.*, but rather relates to a program guide system that allows real-time data to be stored and updated in a database maintained on a users' program guide platform. Accordingly, it is respectfully submitted that the combination of these references do not make obvious applicants' invention as recited in the subject claims. Accordingly, this rejection should be withdrawn.

D.   Conclusion

For at least the above reasons, the claims currently under consideration are believed to be patentable over the cited reference. Accordingly, it is respectfully requested that the rejections of claims 1-67 be withdrawn.

If any additional fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP131US].

Respectfully submitted,
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VIII.   Claims Appendix (37 C.F.R. §41.37(c)(1)(viii))

1.   A system for providing program criteria comprising:

a server computer storing a plurality of tokens, each token having a system unique identifier for identifying a predetermined at least one of an audio and visual program;

wherein the server is programmed to provide at least one token to a remote computer based on received selection criteria.

2.   The system of claim 1, wherein the server is programmed to transmit a message to the remote computer based on the selection criteria, the message including the at least one token.

3.   The system of claim 2, wherein the message is a text email message, the token being operatively associated with the email message.

4.   The system of claim 3, wherein the token is an attachment to the email message.

5.   The system of claim 1, wherein the server computer is further programmed to store corresponding program data as an attribute of each token, the server providing corresponding program data with each token.

6.   The system of claim 1, wherein a program database is stored at the server computer, the program database including the plurality of tokens identifying a plurality of at least one of audio and visual programs.

7.   The system of claim 1 wherein, in response to a translation request, the server is programmed to translate a token into a useable format for programming a recording system to record a predetermined at least one of an audio and visual program in a tuning space associated with the recording system.

8.   The system of claim 7, wherein the server is further programmed to select a tuning space based on identifying data provided with the translation request.

9.   The system of claim 8, wherein the server stores a unique identifier for each recording system registered with the server, each unique identifier being associated with tuning space information for each respective recording system.

10.   The system of claim 9, wherein the useable format includes programming data identifying at least two of date, channel, time, and duration associated with each token provided with the translation request.

11.   The system of claim 1, wherein the server is further programmed to store the plurality of tokens as part of a programmable database, the server updating the programmable database in response to receiving an update request at the server.

12.   The system of claim 11, wherein the server is further programmed to notify the remote computer in response to receiving an update request that modifies program criteria for a program represented by the at least one token.

13.   The system of claim 12, wherein the server stores a different identifiable characteristic for each token obtained from the server, the server employing an identifiable characteristic to notify the remote computer of changes in program criteria for a program represented by the at least one token.

14.   The system of claim 13, wherein the server is further programmed to provide at least one of a token and updated programming data to the remote computer in response to receiving an update request that modifies program criteria for a program represented by the at least one token previously provided to the remote computer.

15.   A computer-readable medium having computer-executable components comprising:
    a token database component for storing tokens, each token representing a different one of at least one of an audio and visual program; and
    a message component with which at least one token is transmitted in response to a request for the at least one token.

16.   The computer-readable medium of claim 15 having further computer-executable components comprising a user interface component for receiving selection criteria having program characteristics indicative of at least one of an audio and visual program.

17.   The computer-readable medium of claim 16 having further computer-executable components comprising a search component for locating at least one token from the token database component based on the selection criteria.

18.   The computer-readable medium of claim 15 having further computer-executable components comprising a program database component that includes the token database component, the program database component associating at least one attribute with each token, the at least one attribute being provided with the at least one token.

19.   The computer-readable medium of claim 15 having further computer-executable components comprising a translation component for, in response to a translation request, translating a token into programming data having a useable format for programming a recording system to record a predetermined at least one of an audio and visual program in a tuning space associated with the recording system.

20.   The computer-readable medium of claim 19 wherein translation component includes further computer executable instructions for selecting a tuning space based on identifying data provided with the translation request.

21.   The computer-readable medium of claim 19 wherein the token database component comprises further computer-executable components for updating the programming data in response to receiving an update request.

22.   The computer-readable medium of claim 15 having further computer-executable components comprising a notification component for notifying a remote computer in response to receiving an update request that results in modifying program criteria for a program represented by the at least one token.

23.   The computer-readable medium of claim 22, wherein the notification component comprises further computer-executable components for providing at least one of a token and updated programming data to the remote computer in response to receiving an update request that modifies program criteria for a program represented by a token previously provided to the remote computer.

24.   A system for providing program criteria comprising:
        means for storing token data representing a plurality of audio and/or visual programs; and
        means for providing selected token data in response to a query identifying program selection criteria.

25.   The system of claim 24 further including means for updating the token storing means in response to an update request.

26.   The system of claim 25 further includes means for providing at least one of a token and updated programming data to a remote computer in response to receiving an update request that modifies program criteria for a program represented by a token previously provided to the remote computer.

27.   The system of claim 24 further including means for translating a token into a useable format for programming a remote recording system to record a predetermined at least one of an audio and visual program in a tuning space associated with the recording system.

28.   The system of claim 24, wherein the means for providing selected token data further includes means to send a message a remote computer based on the query, the message including selected token data.

29.   The system of claim 24, wherein the message is a text email message, the selected token being operatively associated with the email message.

30.   A method for providing program criteria to facilitate programming of a recording system, the method comprising:

sending a token from one computer to another computer based on selection criteria received at the one computer, the token representing a specific at least one of an audio and visual program.

31.   The method of claim 30 further including searching a program database for the token based on the selection criteria.

32.   A method for providing program criteria to facilitate programming of a recording system that, the method comprising

storing a plurality of tokens in a database at a first computer, each token identifying at least one of an audio and visual program;

receiving selection criteria from a second computer;

selecting at least one token based on the selection criteria; and

sending a message to a remote computer, the message having the selected at least one token associated with the message.

33.   The method of claim 32 further including searching a program database for a token representing at least one of an audio and visual program corresponding to the selection criteria.

34.   The method of claim 32, wherein the step of sending further includes sending the message to the remote computer based on address data provided by the second computer, the remote computer being different from the second computer.

35.   The method of claim 32, wherein the remote computer and the second computer are the same.

36.   The method of claim 32 further including updating the database at the first computer in response to an update request received at the first computer.

37.   The method of claim 36 further including providing at least one of a token and updated programming data to a remote computer in response updating the database so as to modify program criteria for a program represented by a token previously provided to the remote computer.

38.   The method of claim 32 wherein, in response to a translation request, a token is translated into programming data having a useable format for programming a remote recording system to record a predetermined at least one of an audio and visual program in a tuning space associated with the recording system.

39.   The system of claim 32, wherein the message is a text email message, the selected token being operatively associated with the email message.

40.   A system to facilitate remote programming of a recording system, comprising:
       a server operable to receive a token having data identifying at least one of a user and the recording system and identifying at least one of an audio and visual program, the server being operable to communicate program data, based on the token, to a programmable recording system to effect programming of the recording system to record the at least one of an audio and visual program.

41.   The system of claim 40, wherein the server is a first server, the token being provided as a request from a second server in response to a user selection associated with the at least one of an audio and visual program.

42.   A system to facilitate remote programming of a recording system, comprising:
       a first server operable to receive data indicative of a user selection, the first server providing a request to a second server, the request having data identifying at least one of an audio and visual program selected by the user and data identifying at least one of the user and a recording system.

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43.   The system of claim 42, wherein the second server is operable to communicate program data, based on the request, to a programmable recording system to effect programming of the recording system to record the at least one of an audio and visual program.

44.   A user interface to facilitate remote programming of a recording system, comprising:

a selectable display portion associated with at least one of an audio and a visual program; and

a process associated with the display portion to effect programming of a recording system to record the at least one of an audio and visual program in response to selection of the display portion, wherein the process is resident at a server operable to communicate program data to the recording system based on the selection to effect programming of the recording system.

45.   The system of claim 44, wherein the program data includes local scheduling data for programming the recording system in a local tuning space associated with the recording system.

46.   A method comprising:

receiving program content criteria from a user via a communication link;

selecting program content based on the program content criteria received from the user;

transmitting a programming component identifying the selected program content, the programming component being operable to effect recording of a program corresponding to the program content.

47.   The method of claim 46, wherein the programming component is transmitted to a computer associated with the user.

48.   The method of claim 46, wherein the programming component is transmitted to a recording system.

49.   The method of claim 46, wherein the programming component is transmitted to a server.

50.   A computer-readable medium having computer-executable instructions for performing the steps of claim 46.

51.   A method comprising:

transmitting for display on a remote computer information about at least one of audio and visual content;

receiving from the user computer a selection of the content; and

transmitting a programming component identifying the selected content, the programming component being operable to effect recording of a program corresponding to the program content.

52.   The method of claim 51, wherein the programming component is transmitted to the remote computer.

53.   The method of claim 51, wherein the programming component is transmitted to a recording system.

54.   The method of claim 51, wherein the programming component is transmitted to a server.

55.   The method of claim 51, wherein the step of receiving further includes receiving information identifying the user.

56.   The method of claim 51, wherein the step of receiving further includes receiving information identifying a device associated with the user.

57.   The method of claim 51, wherein the step of receiving further includes receiving information identifying a local tuning space and system configuration for a device.

58.   A computer-readable medium having computer-executable instructions for performing the steps of claim 51.

59.   A method comprising:

storing programming information;

receiving from a computer user information and information describing at least one of audio and visual content;

using the stored programming information and the user information to construct a token that includes information sufficient to program a recording system to record the at least one of audio and visual content; and

transmitting the token via a communication link.

60.   The method of claim 59, wherein the computer is a remote computer.

61.   The method of claim 60, wherein the remote computer is a portable computer.

62.   The method of claim 59, wherein the computer is a server.

63.   The method of claim 59, wherein the user information includes information identifying characteristics of a device associated with the user.

64.   The method of claim 59, wherein the step of transmitting further includes transmitting the token to the computer.

65.   The method of claim 59, wherein the step of transmitting further includes transmitting the token to a recording system.

66.   The method of claim 59, wherein the step of transmitting further includes transmitting the token to a server.

67.   A computer-readable medium having computer-executable instructions for performing the steps of claim 59.

IX.   **Evidence Appendix (37 C.F.R. §41.37(c)(1)(ix))**

None.

X.   **Related Proceedings Appendix (37 C.F.R. §41.37(c)(1)(x))**

None.